

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte DAVID T. MEDIN, TODD A. HERMANSON, AND SCOTT L. KAYSER

Appeal No. 2002-0540
Application No. 09/589,434

ON BRIEF

Before HAIRSTON, DIXON, and BARRY, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

A patent examiner rejected claims 1-15, 17-20, and 22. The appellants appeal therefrom under 35 U.S.C. § 134(a). We reverse.

BACKGROUND

The invention at issue on appeal is used to add memory to "industrial personal computers." (Spec. at 1.) According to the appellants, rows of industrial personal computers ("PCS") are stored in racks. Each row includes multiple PCS; "the PCS are coupled to wiring associated with the rack and other equipment. . . ." (*Id.* at 5.)

A compact flash memory can be coupled to a PC via an expansion slot of the PC. Using such slot, assert the appellants, however, "reduces the overall versatility of the PC." (*Id.* at 2.)

In contrast, the appellants explain that their invention expands "non-volatile memory for an industrial PC without the need for consuming a valuable planar expansion slot." (Appeal Br. at 8.) An understanding of the invention can be achieved by reading the following claim.

18. A PC comprising:

backplane means for distributing signals in said PC to expansion cards; and,

means for receiving a compact flash expansion card, coupled to said backplane means.

Claims 1, 18-19, and 22 stand rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,694,291 ("Feightner"). Claims 2-15, 17, and 20 stand rejected under 35 U.S.C. § 103(a) as obvious over Feightner and U.S. Patent No. 3,755,771 ("Brush").

OPINION

Rather than reiterate the positions of the examiner or the appellants *in toto*, we address the point of contention therebetween. The examiner asserts, "Feightner teaches . . . a plurality of expansion slots (34, fig. 2) inherently capable of receiving compact flash expansion cards. . . ." (Examiner's Answer at 3.) The appellants argue, "[i]t is improper and in error for the Examiner to . . . equate a standard expansion slot to a compact flash slot. " (Appeal Br. at 6.) In addressing the point of contention, the Board conducts a two-step analysis. First, we construe the claims to determine their scope. Second, we determine whether the construed claims are anticipated or would have been obvious.

1. CLAIM CONSTRUCTION

"Analysis begins with a key legal question -- *what* is the invention *claimed*?" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). "Claims are not interpreted in a vacuum, but are part of and are read in light of the specification." *Slimfold Mfg. Co. v. Kinkead Indus., Inc.*, 810 F.2d 1113, 1116, 1 USPQ2d 1563, 1566 (Fed. Cir. 1987) (citing *Hybritech Inc. v. Monoclonal Anti-bodies, Inc.*, 802 F.2d 1367, 1385, 231 USPQ 81, 94-95 (Fed. Cir. 1986); *In re Mattison*, 509 F.2d 563, 565, 184 USPQ 484, 486 (CCPA 1975)).

Here, independent claim 1 recites in pertinent part the following limitations:

"a compact flash expansion slot coupled to said planar member, so that a compact flash memory expansion card can be coupled to the PC without using one of the planar expansion card slots." The appellants' specification defines the "[c]ompact flash expansion slot" as "any slot or connector which is compliant with the industry standard CF+ types I or II slot, as defined by the compact flash CF+ specification maintained by the Compact Flash Association of Palo Alto, California." (Spec. at 5-6.)

For its part, independent claim 18 recites in pertinent part the following limitations: "means for receiving a compact flash expansion card. . . ." The appellants' specification defines the "compact flash expansion card" as "any expansion card, whether it is a memory card, disk drive, or any other device which is designed for use with and compliant with the industry standard CF+ types I or II slot, as defined by the compact flash CF+ specification maintained by the Compact Flash Association of Palo Alto, California." (*Id.*) "Examples of such expansion cards include memory cards (which are usable in various devices, such as Windows CE handheld computers, digital cameras, PCMCIA adapters for laptop computers, etc.)" (*Id.*) Independent claim 8 recites "a compact flash expansion card slot for receiving a compact flash expansion card therein."

Reading "compact flash expansion slot" and "compact flash expansion card" in light of the specification, claims 1 and 18 require an expansion slot and an expansion slot, respectively, that complies with the industry standard CF+ types I or II slot defined by the compact flash CF+ specification maintained by the Compact Flash Association of Palo Alto, California. Claim 8 requires an expansion slot and an expansion card that both comply with the industry standard CF+ types I or II slot defined by the same specification of the same Association.

2. ANTICIPATION AND OBVIOUSNESS DETERMINATIONS

"Having construed the claim limitations at issue, we now compare the claims to the prior art to determine if the prior art anticipates those claims." *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349, 64 USPQ2d 1202, 1206 (Fed. Cir. 2002). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (quoting *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991)) "Inherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Oelrich*, 666

F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (citing *Hansgird v. Kemmer*, 102 F.2d 212, 214, 40 USPQ 665, 667 (1939)).

Here, the examiner equates the claimed "compact flash expansion slot" to "Feightner['s] . . . slots (34, fig. 2). . . ." (Examiner's Answer at 3.) He alleges that these slots 34 are "**inherently** capable of receiving compact flash expansion cards. . . ." (*Id.* (emphasis added).) For its part, the reference describes these slots as "main memory slots 34," col. 3, l. 18, of a "Baby-AT motherboard 14. . . ." *Id.* at ll. 15. We find no evidence that an expansion card that complies with the industry standard CF+ types I or II slot defined by the compact flash CF+ specification maintained by the Compact Flash Association of Palo Alto, California, however, is necessarily inserted in any of Feightner's main memory slots 34. To the contrary, we agree with the appellants that "[t]he Feightner reference does not . . . mention compact flash [n]or suggest the desirability of having an expansion slot which is compliant with the CF+ specification for compact flash memory." (Appeal Br. at 6.) Therefore, we reverse the anticipation rejection of claim 1, of claim 18, and of claims 19 and 22, which depend from claim 18.

"In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443,

1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)). "A *prima facie* case of obviousness is established when the teachings from the prior art itself would . . . have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Here, the examiner does not allege, let alone show, that the addition of Brush cures the aforementioned deficiency of Feightner.¹ Therefore, we reverse the obviousness rejection of claims 2-7, which depend from claim 1; of claim 8; and of claims 9-15 and 17, which depend from claim 8.

CONCLUSION

In summary, the rejection of claims 1, 18, 19, and 22 under § 102(b) is reversed. The rejection of claims 2-15 and 17 under § 103(a) is reversed.

¹In an *ex parte* appeal, "the Board is basically a board of review — we review . . . rejections made by patent examiners." *Ex parte Gambogi*, 62 USPQ2d 1209, 1211 (Bd.Pat.App. & Int. 2001). Here, our review was limited to the examiner's application of Feightner and Bush. Our reversal should not be construed to imply that no reference could cure the deficiency of Feightner.

REVERSED

KENNETH W. HAIRSTON
Administrative Patent Judge

JOSEPH L. DIXON
Administrative Patent Judge

LANCE LEONARD BARRY
Administrative Patent Judge

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